IN THE

Supreme Court of the United States

OCTOBER TERM, 1960.

No. 232

POPEIL BROTHERS, INC.,

Petitioner,

vs.

KARL ZYSSET AND NEW-NEL KITCHEN PRODUCTS COMPANY,

Respondents.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI AND CONTRA MOTION TO VACATE PORTION OF COURT OF APPEALS' JUDGMENT AND REMAND TO THE DISTRICT COURT.

ALBIN C. AHLBERG,
1360 Board of Trade Building,
Chicago 4, Illinois,
Attorney for Karl Zysset.

WARREN C. HORTON,
208 South La Salle Street,
Chicago 4, Illinois,
Attorney for New-Nel Kitchen Products Company.

THE BLAKELY-HARRIS PRINTING COMPANY, CHICAGO

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FOREWORD.

The Petition for Certiorari herein is palpably without merit. It asserts alleged facts without reference to the record and which are directly contrary to the facts as found. It represents, without citation of any authority, purported rules of law directly contrary to the actual rules as they are well established. It misrepresents the findings repeatedly adhered to by the courts below. It misrepresents the issues in this cause. It now asserts a pretended issue never before raised in the District Court or the Court of Appeals and which indeed is a sham issue wholly devoid of merit.

STATEMENT OF FACTS.

The Petition for Certiorari makes no statement of the material facts. It contains a section entitled "Statement of the Case" but presents therein only contentions of the petitioner without a single reference to the record or to the facts as found. Indeed, petitioner repeatedly disregards the record and without telling this court that it is doing so. For example, at petition page 7, footnote 4, reference is made to "a matter of common knowledge" which has no support whatsoever in the record, and reference is made to a Wilson and McCallay patent, No. 207,146, which was never pleaded and as to which there is not one word of evidence in this entire case. (See Finding No. 17, Petitioner's Appendix, p. 31.)

The Zysset patent in suit is now belittled for petitioner's present purposes as for a "kitchen gadget." However, as was directly found from the evidence, the present petitioner, before it was held to be a deliberate infringer, was very "laudatory of the devices," and indeed represented falsely "that such devices were originated by or invented by the defendant." (Finding of Fact No. 13, Petitioner's Appendix, p. 30.) The Zysset patent discloses a highly meritorious food chopping tool "possessing many advantages over any of the structures of the prior art" as was expressly found in Finding of Fact No. 22. (Petitioner's Appendix, p. 33). "The device of the patent in suit has had great commercial success and more than 2,000,000 of such devices" had been sold prior to October, 1958. (Finding of Fact No. 31, Petitioners Appendix, pp. 35, 38.)

The patentee respondent is a Swiss national residing in Lyss, Switzerland (Finding No. 2) who himself filed and prosecuted the application for the patent in suit.

The application for patent, when filed, was objected

to by the Patent Office Examiner because of the form of its claims and the principal prior art references directly cited by the Examiner were U. S. Patent No. 2,140,010 to Hanel, and Swiss Patent No. 155,720 to Suter. (Pl. Ex. 3, Def. App. 511,)

In meeting the Examiner's objections, Zysset recast his claims as a broad claim reciting structure in detail, and as a dependent claim, narrow and specific in scope. (Pl. Ex. 3, Def. App. 513.) This was precisely in accord with the provisions of the Patent Office Rules of Practice in Patent Cases; Rule 75 (c) of which states:

> "When more than one claim is presented, they may be placed in dependent form in which a claim may refer back to and further restrict a single preceding claim."

In this form, the application was reexamined by the Patent Office and allowed, and issued February 26, 1957 as Patent No. 2,782,826. (Def. App. 543.)

Based upon the testimony of witnesses heard in open court and upon a series of documents, Pl. Ex. 28 and 29, (Pl. App., 50-76) the court entered Finding No. 28 (Petitioner's Appendix 34, 35) as follows:

> "28. Defendant carried on some negotiations with the representatives of Karl Zysset, plaintiff, for the purchase of the latter's vegetable shredders or choppers or for a license under Zysset's patent rights and therefore knew of the pendency of the application for the patent in suit before it had actually sold vegetable shredders and choppers for which it used a Zysset chopper as a guide or model but such negotiations did not culminate in any agreement between the parties and the terms offered to Zysset by defendant were so low as to make it appear that the defendant never expected or intended that such negotiations would culminate in an actual agreement. With full knowledge of the pendency of Zysset's patent applications, the defendant informed the plaintiff Zysset that it intended to proceed with its manufacture and

sale of the vegetable shredder and chopper charged to infringe whether or not it had a license from plaintiff and it proceeded to do so. The Court finds that the defendant deliberately copied the invention of the patent in suit without authority."

Defendant appealed from the judgment entered October 3, 1958 and obtained a stay of injunction so that it could and did continue its acts then found to infringe.

However, before bringing the appeal to a hearing, defendant filed a Motion to Consider New Evidence and asked that the case be remanded to the District Court for that purpose. Such an order of remand was entered by the Court of Appeals on April 28, 1959, and further evidence was heard commencing July 8, 1959.

After hearing such further evidence, the District Court found that there was in fact "no new evidence of a character such as to change the Court's original opinion" (Petitioner's Appendix, 41) and the defendant's motions were "denied for lack of merit." (Petitioner's Appendix, 42.)

This case then was sent back to the Court of Appeals and it was finally completed and argued, and decided by the Court of Appeals in its opinion of February 11, 1960. In this opinion, the District Court judgment was affirmed in all respects. (Petitioner's Appendix, 23.)

Thereupon, to wit, on February 26, 1960, defendant filed a Petition for Rehearing in the Court of Appeals, a certified copy of which is filed by respondent as an essential part of the record.

In the Petition for Rehearing, defendant pointed out that the court's opinion had called attention to the merits and patentability of the combination including "The sinuosity of the blade and slot in the wiper cup" which was specifically defined in claim 2 but not in claim 1 of the Zysset patent. What the court had said about this in its opinion was (Petitioner's Appendix, 19, 20):

"We agree with the District Court. It applied the correct criteria of invention. The sinuosity of the blade and slot in the wiper cup or plate was wholly novel in concept and an important element in the combination claimed in the patent. It eliminated the problem of particles wedging between multiple blades without loss of the advantage of the additional chopping surfaces, and in combination with the indexing feature produced a result beyond that of mere mechanical improvement over existing art. A novel idea was incorporated."

The defendant therefore contended in the Petition for Rehearing that claim 2 "is the only claim that may be sustained consistently with the essential reasoning of the opinion" and that claim 1 should be held invalid. (Petition for Rehearing, p. 4.) In the Petition, p. 6, defendant further prayed the court

"to order that the District Court be affirmed in holding that Zysset's Claim 2 was valid, and be reversed in holding that Zysset's Claim 4 was valid."

Defendant stated in its Petition, p. 7:

"Only in this way will the metes and bounds of the Zysset invention be properly clarified so as to govern the future conduct of defendant and the public at large."

On April 14, 1960, the Court of Appeals modified its opinion precisely in accordance with the defendant-petitioner's suggestion holding claim 1 invalid, and affirming as to claim 2 "in all other respects." (Petitioner's Appendix, 24.)

It has been twice found by the District Court and twice affirmed by the Court of Appeals that defendant's infringement has been deliberate and inequitable. But the inventor Zysset and the exclusive licensee New-Nel Kitchen Products Company, which

"paid $21,000.00 royalties as down payment there-

> under and committed themselves to additional royalties" (Finding No. 29, Petitioner's App. 35)

have yet to obtain judicial protection of their adjudged rights, although it has been two years since the District Court found that the defendant-petitioner was an intentional and wilful infringer of the Zysset patent in suit, which judgment has been affirmed and reaffirmed by the Court of Appeals for the Seventh Circuit.

THE QUESTION PRESENTED.

The question presented by the Petition is abstruse.

Probably the real question presented by the petition is:

> May the petitioner induce the Court of Appeals to enter an order declaring claim 1 invalid and claim 2 valid, and when the court has done so then take the position that the court has thereby invalidated claim 2?

Alternatively, perhaps the issue is:

> Is a narrow patent claim necessarily invalid because a broader claim is so held?

ARGUMENT.

TO GRANT THE PETITION WOULD BE TO REWARD CONCEALMENT OF PURPOSE, AMOUNTING TO MISLEADING THE COURT.

After the Court of Appeals had held both claims of the Zysset patent valid, the defendant petitioned for rehearing on the ground that it was not consistent with the court's reasoning to hold claim 1 valid in view of its opinion that the Zysset invention resided in combination of the sinuous blade and wiper slot with the indexing feature of the Zysset food chopper. Claim 1, said petitioner, was too broad in that respect since it did not define the blade as being sinuous and did not include in the claimed combination the wiper cup with the continuous sinuous slot which were, however, specifically included in claim 2.

The petitioner, therefore, represented to the Court of Appeals that claim 1 was too broad and prayed the court

> "to order that the District Court be affirmed in holding that Zysset's Claim 2 was valid, and be reversed in holding that Zysset's Claim 1 was valid."

The Court of Appeals did precisely what the defendant thus prayed. Because it did so in accordance with defendant's prayer, the Court of Appeals is now accused by Petitioner with having worked a great "mischief" (Pet., p. 11) and with having "created a patent monopoly which the Patent Office did not grant." (Pet., p. 7.)

If these charges are true, which they are not, we respectfully submit that the petitioner is in no position to complain.

If the Court of Appeals, by granting the petitioner's prayer, was going to leave claim 2 as only a fragmentary

claim not meeting the requirements of Section 112 of the Patent Statute (which we deny), then petitioner should have pointed out that result in its petition for such action.

A DEPENDENT CLAIM IS A SEPARATE AND INDEPENDENT CLAIM. INVALIDITY OF ONE CLAIM OF A PATENT DOES NOT INVALIDATE A SEPARATE CLAIM.

In substantially every patent application, claims are drawn to define the invention which are varying in scope and in context. Generally a claim as broad as is believed valid is included and a narrower claim, specifically defining the invention in all of its aspects, is also included.

If a machine has certain elements believed to be novel as a subcombination, it is entirely proper to present a claim to that feature.

That is precisely what the inventor Zysset did in his application for the patent in suit. As filed, some claims were broad and some were narrow. Some were directed to the indexing mechanism of the food chopper only, and some to the combination of the indexing mechanism and the cooperating sinuous chopper blade and wiper cup with continuous and sinuous slot.

The Patent Office cited the most pertinent prior art including the Suter Swiss patent which petitioner refers to at page 5 of its petition. It objected to the form of Zysset's claims as first presented. In response to the objection, Zysset amended his claims and completely met the objections both as to claim form and as to the Suter Swiss patent. He presented claim 1 as granted directed primarily to the indexing mechanism and not including in that claim either the sinuous blade or the wiper cup with the sinuous continuous slot as described in his specification and shown in his drawings. In claim 2 he defined his invention with

all of the detail of claim 1 and, in addition, included the narrowing specific language defining as part of his combination the particular knife blade and wiper cup of his disclosure. Claim 2 reads:

> "2. A vegetable shredder as set out in claim 1, in which the knife blade is sinuous, a wiper cup is rotatably but axially immovably mounted in the lower portion of the housing for clearing the blade on the upward stroke thereof, said blade passing through a continuous sinuous slot in the bottom of the wiper cup, and a blade-carrying rod passing in tight fit through a plurality of openings in the blade and being secured to the lower end portion of the stem."

The invention defined in this claim obviously is not merely a blade and it is not merely a "sinuous" blade as compared with a "zigzag" blade as petitioner pretends.*

Since claim 2 includes by reference all of the wording that is in claim 1, plus the additional matter above quoted, it is sheer sophistry for petitioner to say that claim 2 is fragmentary.

It is not fragmentary. It is complete and fully complies with the rules and the statute.

It has long been the settled law of patents that the separate claims of a patent define independent inventions and, if one claim of a patent be invalid, it does not follow therefrom that other claims of the patent are invalid.

In *Leeds & Catlin* v. *Victor Talking Machine Co.*, 213 U. S. 301, 319, this very question was considered by this court and the court said in its opinion by Mr. Justice McKenna:

* There is no drawing in the Suter Swiss patent like that of the lower figure on page 5 of the petition and there is no drawing in the Zysset patent like that of the upper figure on the same page. Both figures are created by petitioner and are not reproductions of anything in evidence.

> "Claims are independent inventions. One may be infringed, others not, and the redress of the patentee is limited to the injury he suffers, not by the abstract rights which have been granted him in other claims. One claim may be valid, all the rest invalid,—invalid for the want of some essential patentable attribute. But what is good remains and is unaffected by its illegal associates. In such cases the patent does not stand or fall as a unity."

This rule that separate claims of a patent define independent invention and that the validity of one claim is not necessarily affected by the validity of another in the same patent has been reannounced and followed many times in patent cases and, so far as we can ascertain, the soundness of the rule has never before been questioned. For example, the rule is stated in *Veneer Machinery Co.* v. *Grand Rapids Chair Co.*, 227 F. 419, 425 (C. C. A. 6) as follows:

> "The rule is that each claim embodies a complete invention and in effect is an independent patent for the device it covers."

The opinion cites this court's decision in the *Leeds & Catlin* case and similar expressions of the rule from several additional circuits.

In *Sanitary Refrigerator Co.* v. *Winters*, 24 F. 2d 15 (C. C. A. 7), the same rule was followed and claims 1, 2, 3, 4 and 7 of the patent were held to be valid and infringed in spite of the fact that claims 5 and 6 were held to be invalid. As Judge Evans remarked in that case, the two claims held invalid were "broad, generic claims, while the other five are narrow, specific claims." Thus, in that case the narrow claims were held valid even though broad claims of the same patent were held invalid, precisely as the court has treated the Zysset patent in this case.

The decision by the Court of Appeals for the Seventh Circuit in *Sanitary Refrigerator* v. *Winters* was expressly

affirmed by this court in *Sanitary Refrigerator Co.* v. *Winters*, 280 U. S. 30.

In *Wire Tie Mach. Co.* v. *Pacific Box Corporation* (C. C. A. 9), 102 F. 2d 543, 551, the court expressed again the same rule, saying:

> "Claims of a patent are independent inventions. One may be infringed and others not; one may be valid and the rest invalid. The patent does not stand or fall as a unity."

The rule that each claim of a patent is independent of the other claims and its validity not affected by validity of the other claims was restated by this court in *Altoona Public Theatres, Inc.* v. *American Tri-Ergon Corporation*, 294 U. S. 477, 487, citing the decision of this court in the *Leeds & Catlin* case and many others.

If there is any real issue presented by the Petition for Writ of Certiorari herein, it is simply the often cited question as to whether invalidity of a broad claim of a patent affects validity of a narrower claim of the same patent. That question has been so often decided contrary to the contentions of the petitioner that the petition actually presents no new or real issue warranting the grant of certiorari in this case.

It does not affect the essence of that issue that claim 2 of the patent in suit is cast in dependent form instead of repeating *in haec verba* all of the context of claim 1 which is made a part of claim 2 expressly by reference. That a patent claim may properly include language by reference from another claim without "vain repetition" thereof, as expressly recognized by Rule 75(e) of the Patent Office, was stated by this court in *Graver Tank & Mfg. Co.* v. *Linde Air Products Company*, 336 U. S. 271, 277 wherein

this court stated in its opinion by Mr. Justice Jackson that:

> "* * * vain repetition is no more to be encouraged in patents than in other documents, and claims like other statements may incorporate other matter by reference * * *."

We respectfully submit that it is clear from the decisions of this court and in many courts of appeals that the petitioner's contention that claim 2 is fragmentary and is invalid because claim 1 was held invalid is contrary to the established pertinent rule of law.

CLAIM 2 WAS FULLY CONSIDERED INDEPENDENTLY OF CLAIM 1 AT THE TRIAL, AND WAS HELD VALID.

At the trial claim 1 and claim 2 were each discussed separately and individually by the expert witnesses for both the plaintiffs and the defendant. Each was the subject of both direct examination and cross-examination. Both claims were discussed fully in argument and briefs in the District Court and in the Court of Appeals.

Never at any time before either the District Court or the Court of Appeals, or in any pleading, has the defendant contended that claim 2 of the patent in suit is invalid as failing to comply with the requirements of Section 112 of the Patent Statutes. Yet it has urged that claim 1 is invalid and the same technical objection which it now raises to claim 2 could have been made by defendant at all times in this case. It never did so in either the District Court or the Court of Appeals. It cannot now do so.

The rule is too well settled to be seriously questioned at this time that issues or questions which were not raised in or presented to the trial court or to the Court of Appeals cannot be now raised upon a petition for review of the lower court's decision.

Rule 12(h) of the Federal Rules of Civil Procedure expressly provides that a party waives all defenses which he does not present either by motion as provided in the rules or in his answer or reply, except as to matters of jurisdiction, failure to join an indispensable party, and the like. Certainly the defense that claim 2, being a dependent claim, was invalid under the statute could have been raised in defendant's answer if it had chosen so to do. Indeed, it could have been asserted before the District Court by appropriate amendment of the pleadings either before, during, or after the original trial on the merits or on the second hearing before the court after remand by the Court of Appeals. Such defense was never mentioned and, indeed, even on the Petition for Rehearing in the Court of Appeals the defendant took a precisely opposite position inducing the Court of Appeals upon the defendant's very petition to hold claim 1 invalid and to affirm the holding of validity of claim 2.

In *Virtue* v. *Creamery Package Mfg. Co.*, 227 U. S. 8, 38, this court held that a contention not made either in the Circuit Court or in the Circuit Court of Appeals and which is contrary to the theory on which the case was tried below will not be considered by the Supreme Court.

This rule has been followed literally dozens of times in other decisions of this court and in the decisions of the Court of Appeals in substantially every circuit.

The Court of Appeals for the Eighth Circuit recently expressed the rule in *Torney* v. *Red Owl Stores*, 228 F. 2d 117, 121 as follows:

> "It is elementary that except under very exceptional circumstances a reversal of a judgment may not be had upon grounds not presented to nor passed upon by the trial court." (Citing cases.)

There cannot be the slightest doubt that the pretended question presented by the Petition for Writ of Certiorari herein

was not only never raised in the District Court or in the Court of Appeals in this case but it was actually presented to the Court of Appeals by the defendant on a directly opposite theory. The Court of Appeals was expressly induced by the defendant-petitioner to hold claim 2 of the Zysset patent valid, although holding claim 1 invalid. Certainly the petitioner cannot now for the first time raise this alleged defense directly contrary to the arguments and theory which it presented to the lower court.

DEPENDENT CLAIMS

No particular form is prescribed for patent claims.

Robinson on Patents, Volume 2, page 127, says:

> "No particular form of words is required for the statement of the Claim. The language used must be sufficiently clear and accurate to define the invention to the mind of the reader and convey to him a precise idea of its essential character, * * *"

There are various types of patent claims. One is known as a dependent claim which relates to a preceding or basic claim, referred to by petitioner as a "base claim". It is petitioner's position that, where a basic claim is found invalid, the dependent claim also fails. It is believed that such contention cannot be sustained.

Dependent claims are specifically provided for in *Rule 75(c) of the Rules of Practice in Patent Cases*. The rule states:

> "When more than one claim is presented, they may be placed in dependent form in which a claim may refer back to and further restrict a single preceding claim."

Section 608.01(n) of the Manual of Patent Examining Procedure, which is an official publication of the United States Patent Office, Department of Commerce, refers to dependent claims and contains instructions to the Patent

Office examiners as to dependent claims which are permitted under the foregoing Rule 75(c). The section reads as follows:

"608.01(n) Dependent Claims.

A dependent claim is a claim which incorporates another claim by reference and further restricts the language of the claim incorporated. For example, claim 2, a dependent claim, could read as follows:

2. The product of claim 1 in which * * *

Rule 75(c), permitting dependent claims, reads as follows:

> When more than one claim is presented, they may be placed in dependent form in which a claim may refer back to and further restrict a single preceding claim.

A dependent claim cannot in terms refer back to two or more preceding claims. For example, a claim reading as follows:

7. A machine as specified in claims 5 or 6 (or, 5 and 6) in which * * *

is not permitted. Such a claim disguises the true number of claims, since it is in reality two claims. It is also alternative.

However, a dependent claim may refer to a preceding claim, which in turn refers to another preceding claim, thus a series of dependent claims as follows:

2. The machine of claim 1 in which * * *
3. The machine of claim 2 in which * * *

etc.

is permitted.

There may be several series of dependent claims in a single application. All the claims in each series of dependent claims (*i.e.*, those in addition to the base or independent claim) must either be in immediate consecutive order or as close thereto as is physically possible. In other words, it is permissible to have dependent claims which are dependent on the same dependent claim and are separated therefrom only by each other. (Notice of December 9, 1946, and Memorandum of July 16, 1951, revised.)

A dependent claim, which is otherwise allowable, should not be rejected merely because the basic claim is rejected. See 707.0 (j).*

When renumbering of the claim is necessary, in compliance with Rule 126, particular attention should be given to dependent claims to see that each dependent claim correctly identifies the claim upon which it is built."

Dependent claims are the subject of discussion by textbook writers.

In *Walker on Patents, Volume II*, page 781, it is stated:

"Sub-claims or dependent claims.

With respect to the sub-claims, it should be observed that a sub-claim or dependent claim may only be dependent upon a single main claim. In *Ex parte Hill*, 1924 C. D. 21, 22, 319 O. G. 707, Commissioner Robertson said that:

'The practice of permitting claims drawn in dependent form was approved to an extent in *Ex parte Brown*, 235 O. G. 1355; 1917 C. D. 22. In this case three claims were considered, claim 1 covering a certain combination of elements which were recited in usual form. Claim 2 covered "a structure as specified in claim 1 in combination" with an additional element. Claim 3 covered "a structure as specified in claim 2" in which limitations of the included structure were set forth. These claims were held to "particularly point out and distinctly claim" the invention, so as to meet the requirement of section 4888 of the Revised Statutes'."

In the *1959 Cumulative Supplement to Walker on Patents, Deller's* referring to page 781 of Volume II, it is stated:

* 707.07(j) **State When Claims Are Allowable Except as to Form.**

When the Examiner finds a claim is allowable except as to form, this fact should be stated, the objections as to form being specifically pointed out.

"Sub-claims or dependent claims.

"It is axiomatic that a dependent claim must be read as including the claim (or claims from which it depends (*In re Schuffe*, 113 USPQ 537, 244 F. 2d 320, C. C. P. A., 1957)."

In *Revise & Caesar, Patentability and Validity*, at page 409, it is stated that claims should be complete in themselves except "under proper circumstances a claim may refer to one other claim in the same application or patent." In *Ex part Kracker*, 16 USPQ 99, the Board of Appeals of the Patent Office approved a dependent claim and also in *Ex parte Brown*, 1917 C. D. 22, dependent claims were approved.

In *Ellis, Patent Claims*, at page 145, the author cites *Ex parte Huppke*, 51 USPQ 337, to the effect that a dependent claim should not be rejected merely because its supporting claim is rejected.

There is no reason why a dependent claim should be treated differently from any other claim. Dependent claims are always narrower than the preceding claim, the contents of which are incorporated by reference. Innumerable cases could be cited wherein narrower claims have been sustained where broader claims have been found to be invalid.

In *Walker on Patents, Volume II*, page 780, under the heading of Generic and Specific Claims, the author states that:

"It is proper practice to make a generic claim and also a specific claim, in an application for a patent on a generic invention, even where only one species is described in the specification. (*Hill* v. *Hodge*, 12 App. D. C. 530 (1898); *J. L. Owens Co.* v. *Twin City Separator Co.*, 168 Fed. 259 (1909); *Ryder* v. *Townsend*, 188 Fed. 792 (1911); *Zittlosen Mfg. Co.* v. *Boss*, 219 Fed. 887 (1914); *Paper Bag Pat. Case*, 210 U. S. 405;

Scaife & Sons Co. v. *Falls City Woolen Mills*, 269 Fed. 210, 214, C. C. A. 6 (1913).)

"In such a case, if the inventor's understanding that his invention is primary, turns out to be true, both claims will be valid. But if some invention is afterward discovered in the prior art, which relegates the patent to a secondary place, the specific claim may stand and be valid, though the generic claim is too broad to be maintained."

Depending claims come under the general rule that each claim in a patent in effect constitutes a separate grant and must be separately considered. The only thing about a depending claim is that it incorporates additional limitations by reference. This, of course, is expressly provided for by Patent Office Rule 75(e) and the Supreme Court has stated in *Graver Tank & Mfg. Co.* v. *The Linde Air Products Co.*, 336 U. S. 271, 69 S. Ct. 535, 93 L. Ed. 672:

"While vain repetition is no more to be encouraged in patents than in other documents, claims, like other statements, may incorporate other matter by reference, their text must be sufficient to particularly point out and distinctly claim an identifiable invention or discovery."

This portion of the Supreme Court decision has been quoted in *Borg-Warner* v. *Mall Tool Co.*, 217 F. 2d 850 (CA 7); and *Winslow Engineering Co.* v. *Smith*, 223 F. 2d 438 (CA 9).

To say a dependent claim must necessarily fall if the base claim is invalidated, nullifies all of the rules approving the use of dependent claims.

DEPENDENT CLAIMS ARE NOT ALLOWED BY THE PATENT OFFICE WITHOUT EXAMINATION.

We do not believe that the Patent Office allows claims *without independent examination* and the cases cited by petitioner on page 6 of its petition do not support its statement.

Application of McCarn, 242 F. 2d 797, was a case by the United States Court of Customs and Patent Appeals, affirming the Board of Appeals of the United States Patent Office which affirmed a decision of the Patent Office Primary Examiner rejecting claims for an Adjustable Clamping and Locking Means, wherein all of the claims including dependent claims were rejected on the prior art as being unpatentable.

Ex parte Hofstadter, 96 USPQ 449, was a matter before the Patent Office Board of Appeals which reversed the decision of the Primary Examiner who had rejected dependent claims which did not differ patentably but did differ in immaterial limitations from the principal claim involved in that case.

The Court of Customs and Patent Appeals, in *In re Harza*, 124 USPQ 378, affirmed the Patent Office Board of Appeals as to the rejection of principal claim 1 and dependent claims 4 and 5, but reversed as to other claims, the same being an independent claim and several dependent claims.

The Patent Office Board of Appeals in *Ex parte Karl T. Steik and Stewart C. Fulton*, 31 USPQ 343, reversed a decision of the Patent Office Examiner. The Board of Appeals found patentability in certain broad claims and said it was unnecessary to consider the application of the references to more specific dependent claims.

There is nothing in the foregoing cases to suggest that

claims do not receive careful examination in the Patent Office but in any event claim 2 of the Zysset patent was subjected to consideration in the Patent Office as shown by the fact that it was at first rejected by the Examiner and amended by both the applicant and the Examiner, and the pertinent prior art was discussed in connection therewith.

CONCLUSION.

The Petition for Writ of Certiorari is without merit. No question or issue is presented which is new or novel or which has not heretofore been decided many times, always contrary to petitioner's contentions.

The very basis of the petition is that the Court of Appeals committed error by doing precisely what petitioner induced it to do.

The contention made by petitioner could have been made at the trial of this cause. It was never presented to the District Court nor to the Court of Appeals. It cannot now be raised for the first time at this stage of the case.

The petition should be denied.

Respectfully submitted,

ALBIN C. AHLBERG,
1360 Board of Trade Building,
Chicago 4, Illinois,
Attorney for Karl Zysset.

WARREN C. HORTON,
208 South La Salle Street,
Chicago 4, Illinois,
Attorney for New-Nel Kitchen Products Company.

CERTIFICATE OF SERVICE.

I certify that the foregoing Brief was served by mailing copies of the same to Messrs. Will Freeman and Dimitri D. Allegretti, 135 South La Salle Street, Chicago 3, Illinois, and George B. Christensen, 38 South Dearborn Street; Chicago 3, Illinois, attorneys for Petitioner, this 8th day of August, 1960.

ALBIN C. AHLBERG.